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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91217708
Party	Plaintiff J.B. Marketing International, Inc.
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	02/03/2015
Attachments	First Amended Notice of Opposition.pdf(33263 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of:	)	<b>Opposition No. 91217708</b>
	)	
J.B. MARKETING INTERNATIONAL,	)	
INC.,	)	<b>FIRST AMENDED NOTICE OF</b>
	)	<b>OPPOSITION</b>
	)	
Opposer	)	
	)	Application Serial No. 77/555,704
v.	)	Mark: da vinci & Design
	)	Filed: August 26, 2008
DA VINCI	)	Published: April 8, 2014
KUNSTLERPINSELFABRIK DEFET,	)	
GMBH	)	
	)	
Applicant	)	
_____	)	

**J.B. MARKETING INTERNATIONAL, INC.** (“Opposer”), a corporation organized and existing under the laws of California, with a principal place of business at 4924 Balboa Blvd., Suite 459, Encino, CA 91316, believes it will be damaged by issuance of a registration for the trademark shown in Application Serial No. 77/555,704 and hereby opposes the same.

As grounds for its opposition, Opposer alleges as follows, with knowledge concerning its own acts, and on information and belief as to all other matters:

1. Opposer is a cosmetics company based in Los Angeles, California. Opposer manufactures, distributes and sells in interstate commerce cosmetic brushes under the brand **DA VINCI** (“Opposer’s Mark”).

2. On August 26, 2008, Applicant de Vinci Kunstlerpinselabrik Defet GMBH (“Applicant”) filed Application Serial No. 77/555,704 (the “Application”) on an intent-to-use basis to register the mark shown immediately below (“Applicant’s Mark”):

*da vinci*

3. Applicant applied to register Applicant’s claimed Mark in International Class 021 for “cosmetic and shaving brushes.”

4. Opposer is the senior user of **DA VINCI** in connection with cosmetic brushes in the United States. Opposer bases this on the allegations set forth below.

5. Opposer has continuously used Opposer's Mark in interstate commerce on and in connection with cosmetic brushes since at least as early as 1998.

6. Applicant's alleged first use date of 1988 is incorrect. Applicant did not first use Applicant's Mark in *interstate commerce* in connection with cosmetic brushes in 1988 (nineteen eighty eight), but began such use at a later date after 1998 (nineteen ninety eight).

7. Pleading in the alternative, Applicant's alleged first use date of 1988 is incorrect. Applicant did not make first use of Applicant's Mark in connection with cosmetic brushes in 1988 (nineteen eighty eight) that was sufficient to establish use for purposes of trademark registration, but made no more than token use, and did not begin use sufficient to establish rights in and to a trademark until (if ever) a later date after 1998 (nineteen ninety eight).

8. Pleading in the alternative, if Applicant first used Applicant's claimed Mark before 1998 (nineteen ninety eight) in connection with cosmetic brushes (which Opposer does not concede), Applicant ceased use of Applicant's claimed Mark by, at or after 1998 (nineteen ninety eight). Any rights Applicant may claim to have acquired in Applicant's claimed Mark from its alleged first use in 1988 (which is not conceded) were lost and/or forfeited as a result of abandonment of Applicant's claimed Mark by, at or after 1998 (nineteen ninety eight).

9. When Opposer first used Opposer's Mark at least as early as 1998, or at some point after, Opposer was (and is; or became) the senior user of the **DA VINCI** mark in connection with cosmetic brushes in the United States.

#### **COUNT I – LIKELIHOOD OF CONFUSION**

10. Opposer incorporates the above allegations as if set forth in full herein.

11. Opposer's Mark and Applicant's Mark are virtually identical in appearance, sound, meaning and commercial impression. There is direct overlap between the parties' products – i.e., cosmetic brushes.

12. Because the parties' marks are virtually identical and the parties' products directly overlap, there is a risk consumers will mistake Opposer's products for those of Applicant, and

vice versa. There have already been instances of actual confusion where consumers mistook Applicant's products for those of Opposer. As senior user of **DA VINCI** for cosmetic brushes in the United States, Opposer has superior rights in and to **DA VINCI** over Applicant.

13. Because Opposer is the senior user of **DA VINCI** for cosmetic brushes, a junior user, such as Applicant, may not lawfully use a confusingly similar mark, such as Applicant's Mark, in connection with cosmetic brushes.

14. Applicant's use of Applicant's claimed Mark is likely to continue to cause confusion, mistake or deception in the minds of consumers as to the origin of Applicant's goods and services in violation of Section 2(d) of the Lanham Act, 15, U.S.C. §1052(d), with consequent injury to Opposer and the public.

#### **COUNT II – CONCURRENT USE**

15. Opposer incorporates the above allegations as if set forth in full herein.

16. Pleading in the alternative, and based on Applicant's Allegation of Use, which is not conceded, Opposer and Applicant both used the mark **DA VINCI** in connection with cosmetic brushes in the United States continuously since at least as early January 1998 – over 17 years of continuous concurrent use.

17. By the nature of Applicant's and Opposer's 17 years of concurrent use, there has been an extended period of concurrent use by both Opposer and Applicant.

18. It would be inequitable, unfair and unjust for Applicant to obtain a registration which would give Applicant a basis to claim an exclusive right to use Applicant's claimed mark over Opposer's 17 year continuous use of Opposer's mark. Therefore Applicant is not entitled to registration of Applicant's Mark on the Principal Register or the right to exclusive use of the **DA VINCI** mark in the United States for cosmetic shaving brushes. Applicant's Application should be denied registration on this alternative ground.

#### **COUNT III – ABANDONMENT**

19. Opposer incorporates the above allegations as if set forth in full herein.

20. Pleading in the alternative, and based on Applicant's Allegation of Use, which is not conceded, Opposer and Applicant both used the mark **DA VINCI** in connection with cosmetic

brushes in the United States continuously since at least as early January 1998 – over 17 years of continuous concurrent use.

21. By the nature of Applicant's and Opposer's 17 years of concurrent use, there has been an extended period of concurrent use by both Opposer and Applicant.

22. Applicant, by failing to take any action to alert Opposer to Applicant's claimed use, and by acceding to Opposer's use for 17 years, and by allowing concurrent use for 17 years has failed to police Applicant's claimed Mark so that Applicant's claimed Mark does not signify or have meaning in relation to cosmetic brushes.

23. Applicant has thereby abandoned Applicant's claimed Mark.

24. After 17 years of continuous, concurrent use, Applicant is estopped to challenge Opposer's right to use and continue using Opposer's mark.

25. It would be inequitable, unfair and unjust for Applicant to obtain registration which would give Applicant a basis to claim an exclusive right to use Applicant's claimed mark over Opposer's 17 year continuous use of Opposer's mark. Therefore Applicant is not entitled to registration of Applicant's Mark on the Principal Register or the right to exclusive use of the **DA VINCI** mark in the United States for cosmetic shaving brushes, due to abandonment. Applicant's Application should be denied registration on this alternative ground.

**WHEREFORE**, Opposer requests that this opposition be sustained and that the registration of Application Serial No. 77/555,704 be denied.

DATED: February 3, 2015

LEWITT, HACKMAN, SHAPIRO,  
MARSHALL & HARLAN

By: /s/ Nicholas Kanter  
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### **CERTIFICATE OF SERVICE**

It is hereby certified that on February 3, 2015, a copy of the foregoing FIRST AMENDED NOTICE OF OPPOSITION has been sent by First Class, prepaid, United States Postal Service to da Vinci Kunstlerpinselfabrik Defet GMBH, via its attorney of record, at the address below:

Margaret Mchugh, Esq.  
Kilpatrick Townsend & Stockton LLP  
Two Embarcadero Center, 8th Floor  
San Francisco, California 94111-3833

/s/ Nicholas Kanter  
Nicholas Kanter